

## REMARKS

### 35 U.S.C. § 112 Rejections

Claims 64 and 65 are rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement. The applicants have been asked to show that the subject matter of claims 64 and 65 in this case is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. See *Manual of Patent Examining Procedure (MPEP)*, § 2163.02 (8th Ed., 2nd Rev., 2004). The applicants respectfully traverse this rejection, and submits that the specification, as originally filed, fully supports claims 64 and 65.

Claims 64 and 65 state that “the preference comprises a preference authorizing the player to be located by another player.” As the applicants argued in the February 2, 2004, response, Figs. 14-15 and paragraphs 0060-0062 teach that one player (e.g., John Doe) may be located by another player (e.g., John Smith) by sending a message. However, paragraph 0042 teaches that the location of one player by another may be subject to a player authorizing such location. Thus, the combination of paragraphs 0042-0043 with paragraphs 0060-0062 teaches the subject matter in question of claims 64 and 65 (i.e., the preference comprises a preference authorizing the player to be located by another player).

The Examiner holds the opinion that another player cannot locate a player by sending a message and it is the central authority that locates the player. The Office action continues:

The player may have a player preference that authorizes the central authority to locate him; but not another player. ... When the “another

player” sends the messages, the message goes to the central authority and the central authority locates a player in order to send the player their message. The “another player” does not locate the first player.

It is respectfully submitted, however, that claims 64 and 65 do not require that a player be located by another player directly or limit in any way on how the player is located. Claims 64 and 65 merely require that the player’s preference authorizes the player’s location to be learned by another player. For example, if a player does not authorize his or her location to be located, a message sent to him or her from another player who does not know the player’s location would have not been able to be delivered, and another player would have not been able to locate the player. The specification of the present application clearly teaches that the player’s preference can include a preference authorizing him or her to be located, and therefore allow the central authority to deliver a message from another player who does not know the player’s location, and therefore allow another player to locate him or her.

Thus, the specification as originally filed shows that the inventors, at the time the application was filed, had possession of the invention of claims 64 and 65 with respect to the preference authorizing the player to be located by another player.

Responding to the rejection of claim 15 under 35 U.S.C. 112, ¶ 2, claim 15 has been amended to specify that the first and second menus are sent to the first display from the memory. This rejection has therefore become moot.

### **35 U.S.C. § 103 Rejections**

Responding to the section 103 rejections, the rejection of claims 1-7, 9, 12, 13, 15, 24-27, 29-31, 36, 37 and 39 under 35 U.S.C. 103(a) as being unpatentable over Paulsen et al. (U.S. Pub. No. 2003/0054868 A1, “Paulsen 2003”) in view of Paulsen

(U.S. Pub. No. 2002/0142846 A1, "Paulsen 2002") in view of Dubno et al. (U.S. Patent No. 4,722,053, "Dubno") is respectfully traversed.

Claims 1 has been amended, and reads in relevant part (emphasis added):

In a gaming system comprising a memory, a service station and at least a first gaming location enabling play of a game by a player, apparatus for enabling communication with the service station and the first gaming location comprising:

an interactive first communication unit operable from the first gaming location including a first display visible from the first gaming location ... .. and the first communication unit responding to a selection by the player to enable an order of a selected item from the service station;

an interactive second communication unit operable from the service station, including a second display visible from the service station arranged to display the order and an identification of the gaming location requesting the order, said identification of the gaming location comprising a map; and

a network arranged to transmit data so that messages are displayed on the first display and the second display.

The applicants respectfully submit that none of the cited references teaches or suggests a gaming system whose service station, when displaying an order, displays an identification of the gaming location requesting the order that includes a map.

The examiner holds the opinion that Paulsen 2003 teaches, "a player may 'order' an item, i.e. a specific reservation date and time," and this is ordering a specific reservation event. The examiner further holds,

It is inherent to the system [of Paulsen 2003] that an interactive second communication unit is operable from the service station, including a second display visible from the service station and is arranged to display the order and an identification of the gaming location requesting the order. For example, the restaurant would have to have a display to see the reservation that was ordered.

While a restaurant may need a display to see the reservation that was made by a customer from a gaming location, it is not inherent for the system of Paulsen 2003 to

include a second display visible from the service station (i.e., the restaurant) that is arranged to display the gaming location requesting the order. The item ordered by the Paulsen 2003 system is a specific reservation event, and there is absolutely no need for the restaurant (or another service station) to know the identification of the gaming location to accept and honor such a reservation, much less a map showing the gaming location.

Therefore, Paulsen 2003 does not even teach or suggest a second display arranged to display any identification of the gaming location requesting the order (which is not the same as the identification of the player requesting the order), let alone an identification comprising a map.

Paulsen 2002 teaches an interactive game playing preferences in which player preferences are stored in a player account. Dubno teaches a computer operated food service establishment where a customer can order food from an individual patron location provided with a game-playing terminal. Neither of these cited references teaches a second display visible from the service station arranged to display an identification of the gaming location requesting the order that includes a map.

Giraldin et al. (U.S. Pat. No. 6,424,264, "Giraldin") is the only prior art of record using a map for locating people, and teaches a system for tracking in a real-time the location of a group of individuals within a defined environment. It teaches that when a user of the system is looking for a particular member of the group in the defined environment, a map can be displayed indicating the location of the members of the group to help the user find the particular member. The Examiner, in rejecting claims 11, 28, and 35, uses Giraldin to show that "when trying to locate people it is obvious to map

out their locations.” However, Giralдин does not teach or suggest to map gaming locations requesting orders of services.

Furthermore, in order to establish a *prima facie* case of obviousness by modifying the system of Paulsen 2003 in view of Paulsen 2002, further in view of Dubno, and further in view of Giralдин, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” *MPEP*, § 2142, at page 2100-128 (emphases added). The applicants respectfully submit that there is no suggestion or motivation in the prior art to combine the teachings of the four references of record in the manner as defined by claim 1 to have a service station displaying an order and a map showing the gaming location requesting the order. Giralдин suggests that the real-time tracking system of its invention can be used in casinos, but it does not motivate or suggest to map a gaming location when a player requests an order of service from that gaming location. Without using impermissible hindsight to reconstruct the prior art and modifying the systems of prior art using the present invention as a template, the apparatus of claim 1 would have not been obvious to a person of ordinary skill in the art.

Therefore, claim 1 is allowable at least based on the foregoing grounds.

Claims 2-7, 9, 12, 13 and 15 are dependent on claim 1 and are allowable at least for the same reasons as stated above for claim 1.

Claim 24 has been amended in a manner analogous to claim 1 and is allowable for the same reasons as stated above for claim 1.

Claims 25-27, 29-31, 36, 37 and 39 are dependent on claim 24 and are allowable at least for the same reasons as to the allowability of claim 24.

The rejection of claims 14, 16, 17, 38 and 40 under 35 U.S.C. 103(a) as unpatentable over Paulsen 2003 and Paulsen 2002 in view of Dubno and in further view of Kirmse et al. (US. Patent Publication No. 2002/0086732 A1, "Kirmse") is respectfully traversed. Kirmse does not correct the deficiencies of the Paulsen 2003, Paulsen 2002 and Dubno references, as discussed above with respect to claims 1 and 24. Claims 14, 16 and 17 are dependent on claim 1 and are allowable at least for the same reasons as described above for claim 1. Claims 38 and 40 are dependent on claim 24 and are allowable at least for the same reasons as to the allowability of claim 24.

The rejection of claims 18, 19, 21, 22, 41, 42, 43, 45 and 46 under 35 U.S.C. 103(a) as unpatentable over Kirmse is respectfully traversed. Claim 18 has been amended, and reads (emphases added):

18. In a gaming system comprising a plurality of gaming locations, apparatus for enabling communication between a first and a second gaming locations comprising:

an interactive first communication unit operable from the first gaming location and arranged to accommodate a first player, the first communication unit including a first display visible from the first gaming location, enabling entry of at least one of a name of a second player and a second player code and enabling entry of a first message for the second player even when the second player is not at any gaming location;

an interactive second communication unit operable from the second gaming location and arranged to accommodate a second player, the second communication unit including a second display visible from the second gaming location, enabling entry of at least one of a name of the first player and a first player code and enabling entry of a second message for the first player even when the first player is not at any gaming location; and

a network arranged to transmit data resulting in display of a first menu including the first message and the name of the first player on the second display, the first menu enabling selection of a reply menu allowing the second player to enter a reply message to the first player even when the first player is not at any gaming location, the network also being arranged to transmit data resulting in display of a second menu including the second message and the name of the second player on the first display, the second menu enabling selection of a reply menu allowing the

first player to enter a reply message to the second player even when the second player is not at any gaming location.

Kirmse does not teach or suggest such a novel gaming system. The game-messenger system of Kirmse is a combination of a multiplayer gaming system and an online messenger system. A user of the game-messenger system of Kirmse can send a message to another online user of the Kirmse system. However, as Kirmse explicitly teaches and as it is well known in the art about messengers as the one taught in Kirmse, a first client of the Kirmse system can only write a message to a second client when the second client is also online using the Kirmse messenger and is available to receive a message. Put another way, a first client of the Kirmse system cannot write a message to a second client when the second client is not online and is thus not available to receive a message. Such a property of the messenger system of Kirmse severely limits the ability of a player to send messages in its gaming system. Claim 18 of the present invention, on the other hand, enables entry of at least one of a name of a second player and a second player code and enables entry of a message for the second player even when the second player is not at any gaming location and is thus not available to receive the message. The present application teaches, for example, in paragraph 61:

If a player ID number was entered, central authority 120 checks the ID numbers of players whose cards have been read by the system to find a match. If a match is located, the message is forwarded to the gaming location at which the card was read. If no match is found, the system stores the message in memory 121. When the player with the correct ID number inserts his card into a reader, the message is retrieved from memory and is forwarded to the proper gaming location for display.

The message system defined by claim 18 of the present invention is very different from either an email system or a messenger system in the art, and is more like a hybrid of the two. This is a nonobvious advantage in the art over the system described by Kirmse and deserves patent protection. Therefore, claim 18 is allowable.

Claims 19, 21 and 22 are dependent on claim 18 and are allowable for the same reasons as described above for claim 18.

Claim 41 has been amended in a manner analogous to claim 18 and is allowable for the same reasons given above as to the allowability of claim 18.

Claims 42, 43, 45 and 46 are dependent on claim 41 and are allowable for the same reasons given above as to the allowability of claim 41.

The rejection of claims 20, 23, 44, 47 and 48 as unpatentable over Kirmse in view of Paulsen 2003 is respectfully traversed. Paulsen 2003 does not correct the deficiencies of Kirmse as discussed above as to claims 18 and 41. Claims 20 and 23 are dependent on claim 18 and are allowable at least for the same reasons as claim 18. Claims 44, 47 and 48 are dependent on claim 41 and are at least allowable for the same reasons as claim 41. In addition, the examiner maintains its statement that it would have been obvious to implement a card tracking system in the invention of Kirmse. The applicants respectfully traverse the examiner's statement. In the Office action, the examiner obviates the claim limitations related to a card system by equating a card tracking system to any tracking system. The applicants do not attempt to argue that player tracking is useless for any game played over the Internet. But in an internet gaming environment played by users' personal computers as that described in Kirmse, a card tracking system would not only be useless but also be impractical. No one

skilled in the art would have been motivated to combine the internet gaming system of Kirmse with a casino system, such as that described by Paulsen 2003. The examiner has failed to show any motivation or suggestion in the prior art to combine the teachings of Kirmse and Paulsen 2003 in the manner as suggested by the examiner.

The rejection of claims 11, 28 and 35 under 35 U.S.C. 103(a) as unpatentable over Paulsen 2003 in view of Paulsen 2002, in view of Dubno in further view of Giraldin is respectfully traversed. As discussed above as to claims 1 and 24, Giraldin does not correct the deficiencies of Paulsen 2003, Paulsen 2002 and Dubno. Claim 11 depends from claim 9, which is dependent on claim 1, and is allowable at least for the same reasons as to claims 9 and 1. Claim 28 depends from claim 27, which is dependent on claim 24, and is allowable at least for the same reasons as to claims 27 and 24. Claim 35 depends from claim 33, which is dependent on claim 24, and is allowable at least for the same reasons as to claims 24 and 33.

In summary, 1-7, 9, 11-31, 33, 35-48 and 64-65 are allowable, and such action is respectfully requested.

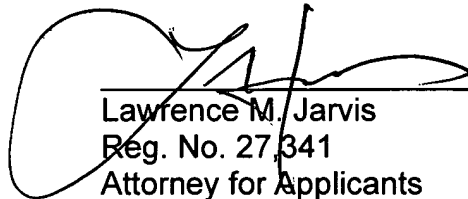
### CONCLUSION

In view of the above amendments and remarks, the applicants respectfully request reconsideration and allowance of all pending claims (1-7, 9, 11-31, 33, 35-48 and 64-65). A Notice of Allowance is respectfully solicited.

A check to pay for the three-month extension fee is enclosed, and the Commissioner is authorized to charge any additional fees or credit overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Date: April 7, 2005

Respectfully submitted,



Lawrence M. Jarvis  
Reg. No. 27,341  
Attorney for Applicants

McAndrews, Held & Malloy, Ltd.  
500 W. Madison, 34<sup>th</sup> Floor  
Chicago, IL 60661  
312 775-8000